

and each rejected claim specified." The Examiner has failed to comply with this burden, and thus withdrawal of the pending rejections is respectfully requested.

While applicants appreciate the Examiner's efforts to identify potentially relevant art, it is imperative that the Examiner not present rejections when the references, or citations within the references, cannot be substantiated as prior art. For example, applicants have already been forced to appeal the claims once because the Examiner insisted that use of the Keyes reference was proper. The application was subsequently withdrawn from appeal because there was no basis to establish the citations in the Keyes reference as prior art.

Now, the Examiner presents new grounds of rejection based primarily on the Omshehe reference (U.S. 2002/0069172) – without providing support to show that the cited passages are prior art. Specifically, the present Office Communication rejects claims 1, 2, 4, 7-9, 11 and 14 under Section 102 based on US 2002/0069172 (Omshehe), and rejects dependent claims 3, 5, 6, 10, 12 and 13 under Section 103 applying Omshehe as the primary reference. However, the Examiner has agreed to the applicants' claimed priority based on EPO 01119041.0 in the chain including PCT/EP02/08352. (See page 8 of the Office Action.) That is, the Examiner apparently affirms that this application is accorded the benefit of the August 7, 2001 priority date. The Omshehe application was filed on September 14, 2001, which is later than the applicant's priority date.

Based on the August 7, 2001 priority date accorded the present application it was urged on the response filed on May 11, 2007 that the Omshehe reference is not prior art to the claimed invention. However, the Examiner now argues: "Yet Omshehe reference can be cited as a reference to form a new set of 102(e) rejection [sic]." (See page 8 of the Office Action.)

The Examiner's intent is unclear and applicants are not obliged to speculate as to the Examiner's bases for asserting rejections. The Applicants prefer not to once again appeal to the Board of Patent Appeals and Interferences in a situation wherein the Examiner has failed to provide clarity and requisite support for the rejections. For the present rejection, as was true for the rejection which was previously placed on appeal, the Examiner has not explained the basis by which the rejection can be supported. The requisite support for sustaining any rejection based on Omshehe is not of record.

Presently, it is not understood how the Examiner intends to apply the Omshehe reference when it is not prior art. The Examiner has not carried his burden to identify which passages in

the Omshehe reference might be considered prior art. That is, the Examiner might argue that the Omshehe reference is based on a provisional application filed September 15, 2000. However, the Examiner has not made any assertion of this sort and certainly has not provided any citation in the corresponding provisional application to support such a rejection. In contrast, when the Examiner improperly rejected the claims based on the Keyes reference (which is not prior art) the Examiner did cite passages of a provisional application to at least argue why the Examiner believed the provisional application was relevant to the claimed subject matter. In that instance, applicants were able to understand the Examiner's position and then demonstrate that the citations which the Examiner relied upon were insufficient to support the rejections. Here, with respect to the Omshehe reference, applicant is left with no guidance and would be forced to second guess the Examiner's intentions. This is because the Examiner has not even suggested how he would apply the Omshehe reference when the filing date of the corresponding non-provisional U.S. application is after applicants' August 7, 2001 priority date. Applicants request that the Examiner comply with MPEP §706 and cease presenting rejections without minimum details required to determine whether the rejections are valid.

In view of the fact that applicants' priority date precedes the filing date of the reference, it still appears unnecessary to distinguish applicants' claims over the art applied in the pending Office Action. However, in the response filed May 11, 2007, the applicants nonetheless did argue that even if the Omshehe reference was determined to be prior art, the reference still could not be a basis for rejecting any of the claims under Section 102 or Section 103. Now, if the Examiner intends to reject the claims based on a priority date accorded via the Omshehe provisional application, then the Examiner must **both** cite the applicable passages of the provisional application and show that the same disclosure was carried forward into the Omshehe published application (2002/0069172). Nothing less would be sufficient to reject the claims.

In reply to applicants' position that the Omshehe reference does not relate to determination of a payment figure "from operations running in the process control system (claim 1), the Examiner has done no more than cite various paragraphs of Omshehe. While Applicants' do not agree that such disclosure is the claimed invention, it is moreover incumbent upon the Examiner to provide citations in a priority application which demonstrate that the citations in the Omshehe publication are prior art. The Examiner must cite applicable passages of the provisional application to support a rejection because the Omshehe reference by itself is not prior art.

Claim 1 expressly requires that the payment figure be determined from operations running in the process control system regarding the creation or removal of a process control function or regarding a user activity or regarding an execution of an automation function. To reject this claim, the Examiner must identify a corresponding “**processs control function**” in the Omshehe provisional application, and must also identify a relationship between “a processor unit adapted to determine a payment figure from operations running in the process control system” and any of the following:

“the creation or removal of a process control function” or

“a user activity” or

“an execution of an automation function.”

None of these bases for determining a payment figure are shown to be of record in a priority document which would allow the Omshehe reference to be used as prior art. Furthermore, as explained in applicants’ detailed description, at paragraph [0026], the user only pays “for the time and/or period, at or during which he uses the functions.”

If it turns out that the Examiner’s rejections do provide a basis for rejecting the claims, the proper basis must be made of record and **applicants must then be given an opportunity to amend the claims if necessary**. At this time, applicants cannot determine whether the Examiner has a valid basis to reject the claims and therefore it is be prejudicial to the applicants that they have not received proper notice of how the prior art is applied - with an opportunity to argue the merits of the rejection and/or amend the claims as a matter of right.

### Conclusion

For all of the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are not properly grounded and it is incumbent upon the Examiner to either remove the rejections and allow the application, or to present a new, non-final office action which presents a proper basis for rejecting the claims and which accords the applicants an opportunity to amend the claims if need be.

**Serial No. 10/763,786**

**Atty. Doc. No. 2001P13794WOUS**

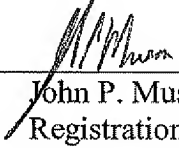
MPEP §707.02 requires the supervisory patent examiner to impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them. That section also requires the supervisory patent examiner to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution.

The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

Dated: 8/23/07

By: \_\_\_\_\_

  
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